

REMARKS

The Final Rejection has been carefully reviewed. Claims 1, 2 and 4-21 are pending. Claims 1, 4 and 5 have been amended. No new matter has been included by these amendments. The amendments to claim 1 incorporate now-canceled claim 3, and the amendments to claims 4 and 5 are necessitated by the cancellation of claim 3. Claim 1 has been further amended to clarify the direction of actuation of the presser device, as disclosed in the specification as published at least at Paras. [0032]; [0034]; [0038] – [0041]; and Figs. 2, 3.

Claims 1-9, 11, 13 and 16-21 have been rejected as allegedly unpatentable under 35 U.S.C. § 103 over U.S. Patent No. 5,282,806 to Haber *et. al.* (“Haber”) in view of U.S. Patent No. 4,213,460 to Weiner (“Weiner”). *See* Final Rejection at ¶ 2. Claims 10 and 14 have been rejected as allegedly unpatentable under 35 U.S.C. § 103 over Haber in view of Weiner and further in view of U.S. Patent No. 4,976,718 to Daniell (“Daniell”). *See* Final Rejection at ¶ 3. Claim 15 has been rejected as allegedly unpatentable under 35 U.S.C. § 103 over Haber in view of Weiner and further in view of U.S. Patent No. 4,748,767 to Sandels (“Sandels”). *See* Final Rejection at ¶ 4. Applicants respond as follows.

I. Withdrawal of Requirement to File Certified Copies of Priority Documents.

The Examiner has not repeated the previous requirement to file certified copies of applications filed in Germany on 09 August 2003 ((DE) 103 37 023.4) and 30 June 2004 ((DE) 10 2004 031 682.1) on which applicants based their claim for priority under 35 U.S.C. § 119, wherein Applicants noted in the Amendment and Response filed on May 21, 2008 that the documents were previously filed and in the record. *See* Office Action, January 22, 2008 at ¶ 1. Applicants thank the Examiner for withdrawing this requirement.

II. Withdrawal of Objections To Claims 6-21 Under 37 C.F.R. § 1.75(c).

The Examiner has not repeated the previous objection to claims 6-21 as allegedly being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. *See* Office Action, January 22, 2008 at ¶ 3. Applicants thank the Examiner for accepting amended claims 6-21.

III. Rejections Under 35 U.S.C. § 103.

Claims 1-9, 11, 13 and 16-21 have been rejected as allegedly unpatentable under 35 U.S.C. § 103 over Haber in view of Weiner. *See* Final Rejection at ¶ 2. Claims 10 and 14 have

been rejected as allegedly unpatentable under 35 U.S.C. § 103 over Haber in view of Weiner and further in view of Daniell. *See* Final Rejection at ¶ 3. Claim 15 has been rejected as allegedly unpatentable under 35 U.S.C. § 103 over Haber in view of Weiner and further in view of Sandels. *See* Final Rejection at ¶ 4. A *prima facie* case of obviousness can be established by showing that the following three criteria are met: (1) there must be some suggestion or motivation to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all the claim limitations. *See* MPEP § § 2143 and 2143.03; citing *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991); *In re Royka*, 490 F.2d 1981 (CCPA 1974).

Additionally, under the Examination Guidelines For Determining Obviousness Under 35 U.S.C. In View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57,526 (October 10, 2007), the Examiner may establish a *prima facie* case of obviousness by setting forth factual findings concerning the state of the art and the teachings of the applied reference(s). *See id.* at 57,527. This includes determining “the scope and content of the prior art . . . ; differences between the prior art and the claims at issue . . . ; and the level of ordinary skill in the pertinent art . . .” *Id.*; *see also* MPEP § 2141; quoting *Graham v. John Deere*, 383 U.S. 1 (1966). The Examiner must then “provide an explanation to support an obviousness rejection under 35 U.S.C. 103 . . . 35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed.” *Id.*

For at least the following reasons, the Examiner has failed to establish a *prima facie* case of obviousness under any of these methods. Accordingly, for at least the following reasons, Applicants respectfully request withdrawal of these rejections under 35 U.S.C. § 103(a). Applicants further note that the Examiner has not set forth any grounds for claim 12, and accordingly requests that allowance of the same be noted in the record.

A. Claims 1-9, 11, 13 and 16-21.

Claims 1-9, 11, 13 and 16-21 have been rejected as allegedly unpatentable under 35 U.S.C. § 103 over Haber in view of Weiner. *See* Final Rejection at ¶ 2. As an initial matter, Applicants note that claim 3 has been canceled, and accordingly this rejection is moot with respect to this claim and should be withdrawn.

With respect to claim 1, the Examiner states that “Haber [] discloses a device comprising:

a housing 184; a spreadable gripper tool 10a; a spreader device 14a, separate from the gripper tool; a rotation device 82a; and a presser device 78a/232 that acts in the axial direction of the device to actuate the spreader device and the rotation device of the gripper tool . . . Haber et al. further discloses the gripper tool being detachable (Col. 6 ll. 25-28) . . . Haber et al. further discloses actuation of the presser device effecting a spreading of the gripper tool by the spreading device; the actuation of rings 16a and 18a of Haber et al. is the first actuation and causes the presser device 232 to spread the gripper device . . . Haber et al. also discloses a second actuation (the pulling of trigger 80a) that effects the rotation of the gripper tool (Fig. 6A) . . . Haber et al. further discloses the gripper tool being closed by the first actuation; actuating the rings 16a and 18a also affects the closing of the gripper . . . Haber et al. discloses the first actuation being into the device (the rings 16a and 18a move inward, into the device) and the second actuation being either into (pushing the trigger 80a) or outward (pulling the trigger 80a) both having the effect of rotating the gripper (Figs. 6A-6B) . . . Haber et al. discloses the gripper being formed of two segments 28A/28B . . . Haber et al. further discloses the segments of the gripper tool forming inward facing jaws (Fig. 9A) . . . Haber et al. further discloses the gripper being interchangeable and replaceable (Col. 1 ll. 66-68) . . . Haber et al. further discloses an ejector device that detaches the gripper tool (Col. 6 ll. 45-50) . . . Haber et al. further discloses a spring force against which the spreading of the segments takes place (Col. 12 ll. 50-55).” See Final Rejection at ¶ 2. The Examiner notes that “Haber et al. does not disclose the gripper tool in its un-spread position encloses an essentially closed cavity that is designed to contain a tick.” *Id.* The Examiner further states that “Weiner discloses a gripper 22/24 that defines a closed cavity designed to contain a tick . . . Weiner further discloses the device having an apparatus to paralyze or kill the parasite (Col. 4 ll. 28-40) and that the gripper tool comprises a moisture dispenser (Col. 4 ll. 28-40) . . . Weiner further discloses the gripper being coated in adhesive (Col. 5 ll. 5-8).” *Id.*

The Examiner concludes that “[i]t would have been obvious to one having ordinary skill in the art at the time of the invention to modify the device of Haber et al. with the gripper of Weiner in order to facilitate the secure gripping of the tick with the device.” *Id.*

Applicant respectfully submits that Haber in combination with Weiner does not support a *prima facie* case of obviousness in that the combination does not disclose each and every

element of the claimed invention. Specifically, Applicants respectfully submit that Haber does not disclose the limitations of claim 1, as amended, of a presser device that is actuated in the axial direction of the device to actuate the spreader device and the rotation device of the gripper tool, wherein a first actuation of the presser device effects a spreading of the gripper tool by the spreading device.

1. Haber does not disclose a “presser device” that is actuated in the axial direction of the device to actuate the “spreader device.”

The Examiner asserts that Haber discloses a spreadable gripper tool 10a; a spreader device 14a, separate from the gripper tool; and a presser device 78a/232 that acts in the axial direction of the device to actuate the spreader device, and also that actuation of the presser device effects a spreading of the gripper tool by the spreading device. Final Rejection at ¶ 2. According to the Examiner, actuation of rings 16a and 18a of Haber is the first actuation which causes the presser device 232 to actuate the spreader device.

Applicants respectfully disagree with this description of Haber. Haber discloses an endoscopic surgical instrument having a removable, rotatable end effector assembly. *See* Abstract. The Examiner asserts that the “spreader device” of the invention is disclosed by driver assembly 14a of Haber; that the “gripper tool” of the invention is disclosed by end-effector assembly 10a; and that the “presser device” of the invention is disclosed by trigger 78a AND axial drive tube 232 of Haber. According to Haber, spreading of end-effector elements 28a, 28b, which are part of end-effector assembly 10a, is accomplished through driver assembly 14a. Col. 6, lines 28-29. End-effector driver assembly 14a comprises finger and thumb rings 16a and 18a, and also an axial drive tube assembly 230 which includes an axial drive tube 232. Col. 7, lines 46-49. Thumb rings 16a, 18a are pivotally connected to axial drive tube 232 through pin 240 which also passes through links 248, 250. Col. 7, lines 50-57; Figs. 9A; 9B; 10B. “[M]ovement of finger and thumb rings 16a, 18a **towards and away from each other** causes links 248, 250 to articulate, thus driving axial drive 232 along axis 22a.” Col. 7, lines 57-60 (emphasis added). Axial movement of axial drive tube 232 “causes end-effector elements 28a, 28b to open and close in a grasping action.” Col. 8, lines 13-19. Actuation of the “spreader device” of Haber (the end-effector elements 28a, 28b) is caused by the “scissors-like” movement of thumb rings, 16a, 16b, which are NOT actuated in the axial direction of the device. Accordingly, Haber does not

disclose a “presser device” that is actuated in the axial direction of the device to actuate a “spreader device.”

2. Haber does not disclose a “presser device” that is actuated in the axial direction of the device that actuates a “spreader device” AND a “rotation device.”

The Examiner further asserts, citing to Fig. 6A, that Haber discloses a rotation device 82a, and that the pulling of trigger 80a effects the rotation of the gripper tool (Fig. 6A). According to the Examiner, citing to Figs. 6A-6B, Haber discloses that the gripper tool is closed by a first actuation, which is actuation of thumb rings 16a and 18a, and a second actuation of either pushing trigger 80a inward or pulling trigger 80a outward rotates the gripper. Applicants respectfully traverse this rejection for at least the reason that Haber does not disclose a single presser device that is actuated in the axial direction of the device to actuate both a spreading device and a rotation device, as claimed in claim 1.

As an initial matter, Applicants note that Figs. 6A-6B depict a different embodiment than the embodiment in Figs. 8A-10B. The Examiner cites to elements of Figs. 6A-6B for disclosure of rotation of the gripper tool, but to elements of Figs. 8A-10B for actuation of the spreader device.¹ Applicants respectfully submit that the rejections should be withdrawn for this reason alone because this rejection cites elements taken from different embodiments in the cited reference.

Further, Haber discloses that rotation of end-effector elements 28a, 28b is effected by end-effector element rotator assembly 20a. Col. 6, lines 30-33. A cam pin 82a extends through trigger 78a and into spiral groove 90a such that “axial movement of trigger 78a causes cam pin 82a to move along spiral groove 90a, thus rotating end-effector carrier tube 8a and end-effector assembly 10a . . . about axis 22a.” Col. 7, lines 26-33. Rotation of axis 22a results in rotation of end-effector elements 28a, 28b. Col. 6, lines 30-33. There is no disclosure in Haber of any “presser device” that BOTH spreads a “spreader device” AND rotates a “rotation device.” The lack of any connection between the assemblies that spread the “spreader device” and rotate the “rotation device” of Haber can further be seen in Fig. 10B, in that pin 240, which passes through

¹ The elements of Haber cited to with regard to the spreader device – elements 10a, 14a, 16a, 18a, 78a and 232 are found on the embodiments of Figs. 8A-10B but they are NOT found on the embodiment of Figs. 1-7B.

links 248, 250 to pivotally connect thumb rings 16a, 18a to axial drive tube 232 to spread end-effector elements 28a, 28b, does NOT engage with trigger 78a, which is actuated to rotate end-effector elements 28a, 28b.

Accordingly, the device of Haber does not meet the limitations of the invention of claim 1 in that there is no presser device that is actuated in the axial direction of the device to actuate BOTH a spreader device and a rotation device, wherein a first actuation of the presser device effects a spreading of the gripper tool by the spreading device. This rejection should be withdrawn for this reason alone.

3. Weiner does not cure the deficiencies of Haber.

Weiner does not cure the deficiencies of Haber. Weiner discloses tick removing forceps comprising "a pair of closable arms having cup-shaped gripping members affixed to the ends of the arms and adapted to be closed upon and to grip the protruding portion of a tick or other parasite which is attached through biting engagement to the skin of a host animal." Abstract. However, Weiner is not cited for, and further does not disclose, the limitations of claim 1 of a presser device that is actuated in the axial direction of the device to actuate the spreader device and the rotation device of the gripper tool, wherein a first actuation of the presser device effects a spreading of the gripper tool by the spreading device.

Accordingly, the combination of Haber and Weiner does not support a *prima facie* case of obviousness and Applicants respectfully request that this rejection be withdrawn. Further, since claims 2, 4-9, 11, 13 and 16-21 depend from claim 1, the rejection of these claims should be similarly withdrawn.

B. Claims 10 and 14.

Claims 10 and 14 have been rejected as allegedly unpatentable under 35 U.S.C. § 103 over Haber in view of Weiner and further in view of Daniell. See Final Rejection at ¶ 3. Daniell does not cure the deficiencies of Haber. Daniell discloses a forceps for removing a parasite from a human or animal host including first and second arms secured so that they are movable in opposition to one another between an open position and a closed position. Abstract. There is no disclosure of a presser device that is actuated in the axial direction of the device to actuate the spreader device and the rotation device of the gripper tool, wherein a first actuation of the presser device effects a spreading of the gripper tool by the spreading device in Daniell. Since claims 10

and 14 are dependent from claim 1, Applicants respectfully submit that these claims are not obvious over Haber in view of Weiner for the reasons previously stated for claims 2, 4-9, 11, 13 and 16-21.

C. Claim 15.

Claim 15 has been rejected as allegedly unpatentable under 35 U.S.C. § 103 over Haber in view of Weiner and further in view of Sandels. *See* Final Rejection at ¶ 4. Sandels does not cure the deficiencies of Haber. Sandels discloses an arrangement to suffocate a tick or other insect. Sandels does not disclose a presser device that is actuated in the axial direction of the device to actuate the spreader device and the rotation device of the gripper tool, wherein a first actuation of the presser device effects a spreading of the gripper tool by the spreading device. Since claim 15 is dependent from claims 1, 4 and 5, Applicants respectfully submit that these claims are not obvious over Haber in view of Weiner for the reasons previously stated for claims 1, 2, 4-9, 11, 13 and 16-21.

D. The Examiner has not set forth a case for obviousness under the new Examination Guidelines.

The Examiner has also not set forth a case of obviousness of claims 1, 2, 4-11 and 13-21 under the new Examination Guidelines as set forth at 72 Fed. Reg. 57,526 (October 10, 2007). The new Guidelines state that some rationale must be set forth that outlines the reasoning why an invention is obvious. *See id.* at 57,528 (III). Suggested but non-inclusive rationales are described including:

1. Combining prior art elements according to known methods to yield predictable results;
2. Simple substitution of one known element for another to obtain predictable results;
3. Use of known techniques to improve similar devices (methods, or products) in the same way;
4. Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
5. "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
6. Known work in one field of endeavor that may prompt variations of it for use in either the same field or a different one based on design incentives or other market

forces if the variations would have been predictable to one of ordinary skill in the art; and

7. Some teaching, suggestion or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicants have already addressed the last rationale listed above and respectfully submit that the Examiner has not set forth any of the other rationales (or any other rationales either) to support a finding of obviousness.

CONCLUSION

Applicants respectfully submit that claims 1, 2 and 4-21 are in condition for allowance and request allowance of the same.

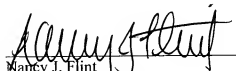
This Amendment After Final Rejection has been filed within two months of the mailing date of the Final Rejection and it is believed that no fees are due for this filing. If any fees are determined to be due, the Commissioner is hereby authorized to deduct such fees from the undersigned's Deposit Account No. 03-0683.

Respectfully submitted,

CARLTON FIELDS, P.A.

Dated: December 29, 2008
Carlton Fields, P.A.
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